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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,118	02/24/2000	Reuven Wachtfogel	NDS-4000 USA	7680

7590 01/25/2007

Welsh & Katz, Ltd.
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EXAMINER	
TRAN, HAI V	
ART UNIT	**PAPER NUMBER**
2623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/515,118	WACHTFOGEL ET AL.	
	Examiner	Art Unit	
	Hai Tran	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-136* is/are pending in the application.

4a) Of the above claim(s) *1-69,74,77-106,108,110,118,120,128,130,131 and 133* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *70-73,75,76,107,109,111-117,119,121-127,129,132 and 134-136* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/11/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Reopened Prosecution

In view of the Pre-Appeal brief filed on 09/25/2006, PROSECUTION IS HEREBY REOPENED. A new Office Action is set forth below.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

KELLEY CHRISTOPHER S.

CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Response to Arguments

Applicant's arguments filed 09/25/2006 have been fully considered but they are not persuasive.

Claim 132, Applicants argues "Akiba does not teach shortened commercials per se, and certainly not short versions of other commercials (i.e., different than the one for which the user requests fast forward). At most, Akiba discloses a fast version of the same commercial for which the user requests fast forward."

In response, the Examiner respectfully disagrees with Applicant because a fast version of the same commercial is certainly a shortened commercial and is different from the non-fast-forward version of the same commercial, see Akiba Col. 12, lines 53-Col. 13, lines 20.

Applicant further argues, "Page 9 of the Final Office Action conceded "Alexander does not clearly disclose decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action." Therefore, neither of the two references addresses the subject of claim 132. "

In response, the Examiner notes Applicant remark; however, page 9 of the Final Office action relates to the rejection of claim 75 and NOT claim 132 as alleged by Applicant. Thus, Applicant remark is moot.

Applicant further argues, "Dependent claim 134 requires the shortened versions of other commercials to comprise "prepared" meaningful shortened versions... Akiba's fast versions are not prepared commercials. In Akiba, "the data processor 11 reads out the recorded data from the recording medium 5 at a predetermined interval corresponding to the reproduction speed." (Akiba, 7:1-3). There is no suggestion of preparing a short commercial that still will be meaningful. Rather, there is merely an automatic selection of screens based on a predetermined interval, without any preparation and without any consideration of whether an intended message will be conveyed."

In response, the Examiner respectfully disagrees with Applicant because Akiba clearly discloses shortened version of other commercials, as discussed above those shortened version of commercials are prepared by the system and is meaningful to user because not all frames of a commercial are suppressed, the viewer able to view and enjoy the shortened version.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 70-73, 76, 111-114, 116, 121-124 and 126 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al. (US 6177931).

Claim 70, Alexander discloses a broadcast system comprising:

A headend for broadcasting program material with commercials (inherently); and

A multiplicity of receiver-decoders at user locations (inherently in order to provide Ads and EPG, as shown in Fig. 1), each receiving the program materials being broadcast and including a commercial unit (Col. 33, lines 8-Col. 35, lines 2) for dealing with the commercials based at least partially on past viewing thereof, wherein each the receiver-decoder deals with the commercials by determining conditions pursuant to which they are viewed by a user,

And the receiver-decoder deals with the commercials by one of the following:

Determining conditions pursuant to which viewing of the commercials may be obviated independently of user action (Alexander utilizes of viewer profile information to provide customized presentation of advertising to the viewer Col. 26, lines 57-Col.27, lines 7; Col. 32, lines 35-48. In view of that, Alexander clearly

obviates commercials that do not fit viewer profile and independently of user action); and

Determining conditions pursuant to which viewing of the commercials is obviated by user action.

Claim 71, Alexander discloses a receiver-decoder (inherently in order to provide Ads and EPG, as shown in Fig. 1) for use with a broadcast system having a headend for broadcasting program material with commercials (inherently) and a multiplicity of receiver-decoders at a user locations (inherently), the receiver-decoder comprising a receiver for receiving the program material being broadcast; and

A commercial unit (Col. 33, lines 8-Col. 35, lines 2) for dealing with the commercials based at least partially on past viewing thereof, wherein the receiver-decoder deals with the commercials by determining conditions pursuant to which they are viewed by a user,

And the receiver-decoder deals with the commercials by one of the following:

Determining conditions pursuant to which viewing of the commercials may be obviated independently of user action (Alexander utilizes of viewer profile information to provide customized presentation of advertising to the viewer Col. 26, lines 57-Col.27, lines 7; Col. 32, lines 35-48. In view of that, Alexander clearly obviates commercials that do not fit viewer profile and independently of user action); and

Determining conditions pursuant to which viewing of the commercials is obviated by user action.

Claim 72, Alexander discloses wherein said receiver-decoder deals with said commercials based at least partially on a history of viewing of said commercials via said receiver-decoder (Col. 34, lines 55-65+).

Claim 73 , Alexander further discloses wherein said receiver-decoder deals with said commercials based at least partially on a history of viewing of said commercials by multiple users (Col. 30, lines 38-45; Col. 33, lines 08-15).

Claim 76, Alexander further discloses wherein said receiver decoder deals with said commercials by determining conditions pursuant to which their viewing may be obviated independently of user action (Alexander utilizes of viewer profile information to provide customized presentation of advertising to the viewer Col. 26, lines 57-Col.27, lines 7; Col. 32, lines 35-48. In view of that, Alexander clearly obviates commercials that do not fit viewer profile and independently of user action).

Claims 111-112, method claims are analyzed with respect to system claims 70-71.

Claim 113, method claim is analyzed with respect to system claim 72.

Claim 114, method claim is analyzed with respect to system claim 73.

Claim 116, method claim is analyzed with respect to system claim 76.

Claims 121-122 are analyzed with respect to system claims 70-71.

Claim 123 is analyzed with respect to system claim 72.

Claim 124 is analyzed with respect to system claim 73.

Claim 126 is analyzed with respect to system claim 76.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 75, 107, 109, 115, 117, 119, 125, 127 and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (US 6177931) in view of Schaefer et al. (US 6490000).

Claim 75, Alexander further discloses wherein said receiver decoder deals with said commercials by determining conditions pursuant to which viewing of said commercials by user action (Col. 28, lines 30-60).

Alexander does not clearly disclose decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action.

Schaefer discloses the decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action (Col. 4, lines 42-Col. 5, lines 08). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with the teaching of obviating commercials, as taught by Schaefer, so to be more effectively control the process of allowing or not allowing user to skip commercials (Col. 1, lines 50-Col.2, lines 15).

Claim 107, Alexander does not disclose the receiver-decoder deals with said one commercial by preventing the user from skipping said one commercial.

Schaefer discloses the receiver-decoder deals with the one commercial by preventing the user from skipping the one commercial (Col. 14, lines43- 56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with Schaefer so to insure that advertisements are viewed by the user (Col. 2, lines 1-8).

Claim 109 , Alexander does not disclose receiver-decoder deals with said one commercial by preventing the user from skipping said one commercial.

Schaefer discloses the receiver-decoder deals with the one commercial by preventing the user from skipping the one commercial (Co!. 14, lines43- 56). Therefore, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to modify Alexander with Schaefer so to insure the advertisements are viewed by the user (Col. 2, lines 1-8).

Claim 115, method claim is analyzed with respect to system claim 75.

Claims 117 and 119, method claim is analyzed with respect to system claims 107 and 109 respectively.

Claim 125 is analyzed with respect to system claim 75.

Claim 127 is analyzed with respect to system claim 107.

Claim 129 is analyzed with respect to system claim 109.

2. Claims 132, and 134-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al (US 6177931) in view of Akiba et al. (US 6377745).

Claim 132, Alexander teaches every limitations of claim 132 as discussed in claim 71.

Alexander does not specifically discloses "Dealing with the commercials, wherein, for at last one of the commercials, the dealing with the commercials comprises dealing with the one commercials by presenting alternative shortened versions of other commercials in response to a user request to view the one commercial in a FF or Fast-backward mode."

Akiba discloses the receiver-decoder deals with the one commercial by presenting a shortened version of said one commercial in response to a user request to view said program material in a fast-forward. If the FF function is not de-

activated by the user, the system keeps presenting to user following commercials in sequence, one after the others (for example during a presentation of a series of commercials during a commercial break, if the user requests a fast-forward mode during the displaying of commercials right after the commercial break is detected by the system. In view of that Akiba system clearly generates/reproduces an alternative version of the series of presenting commercials by manipulating the reproduction of frames of the series of presenting commercials in a manner to obtain a reproduction of the presenting series of commercials in the FF mode that suppresses the viewer's eye strain; Col. 12, lines 53-Col. 13, lines 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with Akiba so to control the reproduction speed of which the video data are read out successively at a predetermined read out interval thereby suppress the user's eye strain with efficient retrieval of the video data, i.e., display commercials in a shorted version.

Claim 134, Alexander in view of Akiba further discloses wherein the alternative versions of other commercials comprise prepared meaningful shortened versions of a full commercials(reads on Akiba FF version of commercials that suppress the user's eye strain with efficient retrieval of the video data, as discussed in claim 132. Indeed, Akiba FF version of commercials is meaningful to viewer because not all frames are suppressed).

Claim 135, Alexander in view of Akiba further discloses wherein each alternative shortened version has a duration of approximately three seconds (Since, Akiba' commercial FF version is a short version of a commercial. Thus, it is obvious that the Akiba 's commercial FF version is approximately to three second!)

Claim 136, Although Alexander in view of Akiba fails to teach a duration of exactly 3 seconds, Alexander in view of Akiba does teach that a short commercial could be presented. Since one of ordinary skill would realize that commercials are often under 30 seconds, therefore it would have been obvious to make conferrals 3 seconds or 5 to allow for viewers to see a product or logo without getting time to become bored or annoyed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht
01/17/2007

HAI TRAN
PRIMARY EXAMINER